UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,448	12/18/2000	Jerome Dale Johnson	P65332	3475

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EXAMINER
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ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
02/05/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@hershkovitz.net
patent@hershkovitz.net

Office Action Summary	Application No.	Applicant(s)
	09/739,448	JOHNSON ET AL.
	Examiner	Art Unit
	Natalie A. Pass	3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *21 October 2009 and 13 August 2009*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6,8-11,20-39 and 41-55* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6,8-11,20-39 and 41-55* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the amendments filed 21 October 2009 and 13 August 2009. Claims 1, 2-6, 8, 10-11, 20-23, 28-30, 50-52 have been amended. Claims 7, 12-19, 40 have been cancelled. Claim 55 has been newly added. Claims 1-6, 8-11, 20-39, 41-55 are currently pending.

Claim Objections

2.   Claim 55 is objected to because of the following informalities: Claim 55 recites "the particular insurance plan being is not" in line 15. For the purpose of applying art Examiner interprets these words to read "the particular insurance plan is not." Appropriate correction is required.

Claim Rejections - 35 USC § 101

3.   The rejection of claims 1-10, 20-29, 50, 53-54 under 35 U.S.C. §101 is hereby withdrawn due to the amendments filed 21 October 2009 and 13 August 2009.

4.   The rejection of claims 1-10, 20-29, 50-54 under 35 U.S.C. 112, first paragraph, is hereby withdrawn due to the amendments filed 21 October 2009 and 13 August 2009.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-6, 8-11, 20-39, 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6,067,522 and Tyler, U.S. Patent Number 5,523,942, for substantially the same reasons given in the prior Office Action (paper number 20090428). Further reasons appear hereinbelow.

(A)   Claims 1, 11, 30 and 50-52 have been amended to include the recitation of

- "an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan" in lines 14-18, 16-20, 17-20, 16-20, 18-22, and 19-22, respectively.

As per these new limitations Lockwood, Warady and Tyler teach a method, system, and computer program product, as analyzed and discussed in the previous Office Action (paper number 20090428), further comprising

an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what "prerequisities" (reads on "conditions") are not met for the customer to qualify for the proposed but currently not configured insurance plan (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 11).

As per the remainder of the amendments to claims 1, 11, 30 and 50-52, these appear to have been made merely to correct minor typographical or grammatical errors, to overcome rejections under 35 USC § 101 and 35 USC § 112, or to clarify the claim language. While these

changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090428, section 10, pages 6-24), and incorporated herein.

The motivations for combining the respective teachings of Lockwood, Warady and Tyler are as given in the rejection of claim 1 in the previous Office Action (paper number 20090428), and incorporated herein.

(B)   As per the amendments to claims 2-6, 8, 10, 20-23, 28-29, these appear to have been made merely to correct minor typographical or grammatical errors or to clarify the claim language. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090428, section 10, pages 6-24), and incorporated herein.

(C)   Claims 9, 24-27, 31-39, 41-49, 53-54 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090428, section 10, pages 6-24), and incorporated herein.

(D)   As per newly added claim 55, Lockwood, Warady, and Tyler teach a method for

generating a customized proposal in the development of insurance plans for a customer, the

method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract,

column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line

32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using

one or more modules (Lockwood; Abstract, column 2, lines 48-55); (Examiner interprets

Lockwood's teachings of "programmed to gather a predetermined sequence of information from

a customer on the services in which the customer is interested … [...] ... transmit the information

to the central data processing center … [...] ... extracts the desired information from its storage

… [...] ... transmits it back to the terminal … [...] ... relayed to the customer" (Lockwood;

column 2, lines 48-55) to teach a form of using one or more software modules, the database

having stored therein insurance plan products with plan requirements data (Lockwood; column

5, lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program

information and information on insurance policies and prices for various insurance companies,

which are periodically up-dated from the terminals 4 of the various companies, and information

on policy quotes and sales, which can be accessed periodically by the respective insurance

company terminals ... [   ] ... to perform insurance quotation calculations in response to customer

information received from any of the terminals, to send quotation data to the respective terminal"

(Lockwood; column 5, lines 37-48) to necessarily include storing in the "memory" (reads on

"database") plan requirements data in order to produce the insurance quotation;

determining if a particular insurance plan may be proposed but is not currently

configured for the customer based upon the stored plan requirements data and either the stored

customer data or user selected plan options by using the one or more modules (Warady; Figure 1,

column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 11, column 8, lines 20-

35, column 9, line 58 to column 10, line 8), the user selected plan options being obtained from an

input device of the computer system (Warady; column 13, lines 50-53);

presenting a description of insurance plan options (Lockwood; column 3, lines 9-48,

column 6, lines 5-11), the options comprising an option currently available to the customer on a

"terminal" (reads on "display device of the computer system") (Lockwood; column 3, lines 9-48,

column 6, lines 5-11) based upon the stored customer data and the user selected plan options by

using the one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner

interprets Lockwood's teachings of "programmed to gather a predetermined sequence of

information from a customer on the services in which the customer is interested … [...] …

transmit the information to the central data processing center … [...] … extracts the desired

information from its storage … [...] … transmits it back to the terminal … [...] … relayed to the

customer" (Lockwood; column 2, lines 48-55) to teach a form of "presenting a description of

insurance plan options currently available to the customer … [...] … by using the one or more

modules"), the description of insurance plan options including an indication that the particular

insurance plan being is not currently configured for the customer, and an indication of what

"prerequisities" (reads on "conditions") are not met for the customer to qualify for the proposed

but currently not configured insurance plan (Warady; Figure 7b, Figure 8, column 5, line 65 to

column 6, line 11; and

generating a customized proposal in the computer system based upon a selection made

from the presented insurance plan options by using the one or more modules, the proposal

including a description of a preferred insurance plan, at least a portion of the customer data, and

estimated costs for the preferred insurance plan (Warady; Figure 8, column 9, line 59 to column

10, line 21, column 10, lines 55-67, column 11, lines 32-35),

wherein the customized proposal resulted from a preliminary proposal module taking a

plan produced by a plan configuration engine module along with cost data to produce a formal

proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65), and

wherein the insurance plans comprise at least one of health insurance plans, life insurance

plans, disability insurance plans, auto insurance plans, or employee insurance benefit plans

(Warady; column 4, lines 1-9).

The motivations for combining the respective teachings of Lockwood, Warady and Tyler

are as given in the rejection of claim 1 in the previous Office Action (paper number 20090428),

and incorporated herein.

Response to Arguments

7.   Applicant's arguments filed 21 October 2009 and 13 August 200 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 21 October 2009 and 13 August 2009.

In the responses filed 21 October 2009 and 13 August 2009 Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added limitations of the amendments filed 21 October 2009 and 13 August 2009, have been fully addressed by the Examiner as being obvious in view of the combined teachings of Lockwood, Warady and Tyler, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20090428), and incorporated herein.

In the response filed 21 October 2009 Applicant makes the following arguments:

a.   applied references fail to teach "a formal proposal;" and

b.   applied references fail to teach "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data. "

Examiner addresses these arguments below.

a.   As per Applicant's assertion in the paragraph bridging pages 16-17 of the 21

October 2009 that the applied references fail to teach "a formal proposal," and Applicants

supporting arguments pointing to "the Examiner's remark at page 27, first paragraph of the

Office action dated May 13, 2009, which appears to indicate that the prior art does not disclose

a method of generating a formal proposal," Examiner notes that the cited paragraph states:

> *"As per Applicant's argument in page 18, lines 15-16 of the 24 February 2009*
> *response that the Tyler reference "does not prepare a formal proposal that had*
> *previously been unavailable to the customer," Examiner respectfully notes that this is*
> *not a claimed limitation."*

Examiner submits that this does <u>not</u> state that the prior art does not disclose a method of

generating a formal proposal, but states that <u>one</u> of the applied references does not teach

preparing a formal proposal <u>that had previously been unavailable to the customer</u>. And Examiner

notes that the cited paragraph <u>further</u> states that this was <u>not a claimed limitation.</u>

As per the teaching of a <u>formal</u> proposal, Examiner can find only <u>one</u> description of or

reference to a "formal" proposal in Applicant's specification, i.e.:

> *"The preliminary proposal generator module 205 takes the plan produced by the plan*
> *configuration engine module 204 along with cost data to prepare <u>a formal proposal</u>*
> *to the customer. This proposal may be in the form of a word processing document*
> *that may be saved and edited. It may also contain personalized graphics data to*
> *uniquely identify the source of the proposal as well as the customer to whom it is*
> *being offered"* (emphasis added) (Specification; page 8, lines 3-7).

Accordingly, Examiner interprets Tyler's teachings of:

"[a] computer implemented graphical user interface for receiving instructions and information relating to insurance products, and for displaying insurance proposals relating thereto" (Tyler; Abstract),

together with Tyler's teachings of

"[t]he present invention ... [...] ... enables a user to intelligently enter all relevant information about an insurance product, regardless of the insurance product or the type of request about an insurance product that the user wishes to undertake. ... [...] ... calculation engine is designed to perform all required calculations related to insurance products. ... [...] ... At its highest level of functionality, the present invention operates as follows. Information about insurance product rules and rates is stored in the memory of a digital computer. The information may be stored as data or as procedures that carry out specific functions. The digital computer is supplied with a specific information request. The information request may be for information about a proposal ... [...] ... In conjunction with the user, the digital computer determines the information request requirements, accesses the required rates, calculates the required information, and displays it to the user or passes it to another computer system. Typical functions that can be performed by the present invention include: (i) collecting information required to design an insurance product for a customer; (ii) receiving a request for information about an insurance product or policy; (iii) accessing stored information, such as rates, performing the necessary calculations based on the request and returning the requested information to the user; and (iii) displaying policy level and component level information at both a "point in time" and over one or more time intervals. The design grid of the representative embodiment of the present invention is a matrix-like graphical user interface. The design grid is used to collect all information from a user required to design an a specific instance of an insurance product, herein called a policy or a proposal. The design grid identifies the information needed to design a policy for the user, presents choices for the user to select while the user is designing the policy, and

> *enables the display of information related to the policy"* (Tyler; column 5, lines 6-50),

together with Tyler's teachings of

> *"The calculation engine of the present invention accesses required rates, performs all required calculations related to the proposal based on the information entered at the design grid, and returns the proposal output to the user"* (Tyler; column 6, lines 58-61)

to teach a form of "wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal" as recited in independent claims 1, 11, 30 50-52 and 55.

Moreover, Examiner submits that the Warady reference also teaches (see Warady; Figure 8) what appears to be Applicant's definition of a formal proposal, as stated in applicant's specification, i.e. *" ... [...] ... a word processing document that may be saved and edited. It may also contain personalized graphics data to uniquely identify the source of the proposal as well as the customer to whom it is being offered"* (Specification; page 8, lines 3-7).

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages.

b.   As per Applicant's assertion in paragraph 3 on page 17 of the 21 October 2009 response that the applied references fail to teach "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data," as recited in claims 50-52, Examiner respectfully disagrees.

Examiner interprets Lockwood's teachings of "[t]he system as applied to the insurance industry is arranged to give personalized insurance quotations, make sales and take orders," (emphasis added) (Lockwood; column 3, lines 40-42) together with Lockwood's detailed "sequence of operations" (Lockwood; column 5, line 65 to column 6, line 32) resulting in a customized proposal to purchase insurance (see steps (1)-(8)) together with Lockwood's teachings of "[e]ach sales and information terminal is programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ["comparing the customer data"], and to transmit the information to the central data processing center. In response to the gathered information, the central data processing center extracts the desired information from its storage and transmits it back to the terminal where it is relayed to the customer … […] … . Subsequently, the terminal is programmed to accept an order for the offered services from the customer, to collect payment and to dispense the services to the customer" (Lockwood; column 2, lines 47-59) to teach a form of "generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data," [i.e. as a result of comparing the customer data, it is only an extracted subset of the stored information, and therefore different from the stored information that is used to present the customer with the personalized insurance product information].

Moreover, Examiner notes that the Warady reference teaches ""[t]he data entry and user interface module 50 enables a user of the health and welfare benefit enrollment and billing system 1 to enter, review, extract, and modify the data stored in the various files of the health

and welfare benefit enrollment and billing system" (emphasis added) (Warady; column 8, lines

26-30), which Examiner interprets to read on the argued limitation.

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at

least the aforementioned passages.

In the response filed 13 August 2009 Applicant makes the following arguments:

a.   applied references fail to teach "presenting … [...] ... an indication … [...] ...

what conditions are not met for the customer to qualify for the … [...] ... insurance plan;"

b.   the Warady reference teaches away from "determining if a particular insurance

plan may be offered despite the fact that one or more requirements are not currently met;"

c.   applied references fail to teach "determining if a particular insurance plan may be

offered but is not currently available to the customer."

Examiner addresses these arguments below.

a.   As per Applicant's assertion in paragraph 1 on page 17 of the 13 August 2009

response that the applied references fail to teach ""presenting … [...] ... an indication … [...] ...

what conditions are not met for the customer to qualify for the … [...] ... insurance plan,"

Examiner respectfully disagrees.

Examiner interprets Warady's teachings of "prerequisites table 110 stores information

describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that

must be met before an employee can be enrolled in the plans. For example, certain life insurance

plans require <u>evidence of insurability</u> of an employee to be approved by the plan provider <u>before</u>

<u>the employee is eligible</u> to receive the chosen … [...] … level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider" (Warady; column 5, line 65 to column 6, line 7) as teaching "an indication of what 'prerequisities' (reads on "conditions") are not met for the customer to be "eligible"(reads on "qualify") for the proposed but currently not configured insurance plan."

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages. Perhaps Applicant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

        b.   As per Applicant's assertion in paragraph 1 on page 19 of the 13 August 2009 response that the Warady reference teaches away from "determining if a particular insurance plan may be offered despite the fact that one or more requirements are not currently met," Examiner respectfully notes that this is not a claimed limitation.

        c.   As per Applicant's assertions in paragraph 3 on page 18 and in paragraph 2 on page 19 and in the paragraph bridging pages 19-20 of the 13 August 2009 response that the applied references fail to teach "determining if a particular insurance plan may be offered but is not currently available to the customer," Examiner respectfully disagrees. Examiner notes that

this claim language has been amended to read "determining if a particular insurance plan may be proposed but is not currently configured for the customer ... [...] ..." and Examiner submits that these issues have been discussed earlier in this Office Action.

The remainder of Applicant's arguments on pages 20-23 of the 13 August 2009 response have been discussed earlier in this Office Action

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

> A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10.   **Any response to this final action should be mailed to**:

                Box AF

        Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please label

"PROPOSED" or "DRAFT" on the front page of the

communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The

examiner can also be reached on alternate Fridays.

12.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the

organization where this application or proceeding is assigned is (571) 273-8300.

13.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
January 31, 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686